

The Examiner further asserts for the first time, in the fourth Office Action, dated June 24, 2009, that these alleged species are independent and distinct. As indicated in the accompanying petition, the Examiner is respectfully reminded that, pursuant to MPEP §809.02(a)

“The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified.” (emphasis added)

However, the mere identification of the alleged species does not meet the requirements to establish a proper Election of Species requirement. Not only must the Examiner clearly identify the alleged species, the Examiner must also demonstrate that the alleged species are independent or distinct. (MPEP §808.02) More specifically, MPEP §808.02 sets forth that criteria of MPEP §806.05(c) - §806.06 must be met.

Specifically, the Examiner alleges at p. 4 of the Office Action dated June 24, 2009, that “[t]he species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species.” Yet the Examiner fails to identify ANY mutually exclusive characteristics. Thus, the Examiner fails to indicate a proper basis for an Election of Species requirement.

Second, in further support of a requirement for an Election of Species, particularly after substantive examination of the same claims, it is incumbent upon the Examiner to establish that an examination and search burden exists. Apparently attempting to establish such a burden the Examiner urges one or more of a collection of reasons, but again fails to identify a specific reason or basis to suggest a burden.

Moreover, Applicants have noted that this is the fourth Office Action, after three prior Office Actions on the merits of the claims, with only minor amendments to some of the independent claims. Applicants respectfully submit that in light of the prior examination of these claims, there is no burden for examination and search that the Examiner has not, or should not, have already addressed. Thus, the requirement for Election of Species fails to set forth any basis to establish that a burden now exists. Absent

identification of a specific burden, a *prima facie* requirement for an election has not been established and Applicants have no obligation to respond.

In light of the Examiner's failure to establish the alleged mutually exclusive characteristics of the alleged species, or to provide support for an alleged burden in examination and searching (after three prior actions on the merits), Applicants respectfully traverse the requirement for an Election of Species, and respectfully request that the requirement be withdrawn and the Examiner move the pending claims to allowance.

Although Applicants traverse the Election of Species requirement on several grounds as noted herein, in order to be fully responsive, Applicants elect Species I, encompassing claims 1 through 5 for examination, with traverse.

Restriction Requirement

At item 4 (p. 6) of the Office Action dated June 24, 2009, the Examiner appears to suggest that a restriction requirement has been set forth based upon product and process claims. Applicants respectfully submit that no such a requirement has been set forth. Moreover, Applicants understand claims 1 – 19 of the instant application to be directed to methods, and fail to understand just what the Examiner urges as “product” claims. Accordingly, the reference to a restriction requirement is believed to be in error and Applicants respectfully request that the Examiner confirm the error in a subsequent communication.

In view of the foregoing remarks and amendments, and the Examiner's disregard for the rules in setting forth the Election of Species requirement after substantive prosecution of the claims, reconsideration of this application and allowance thereof are earnestly solicited. In the event that the Examiner does not withdraw the requirement for Election of Species, Applicants respectfully petition the Commissioner as set forth in the document filed concurrently herewith.

In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 24-0037 for Xerox Corporation.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicants' attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

/Duane C. Basch, Esq. Reg. No. 34,545/

Duane C. Basch

Attorney for Applicant

Registration No. 34,545

Basch & Nickerson LLP

1777 Penfield Road

Penfield, New York 14526

(585) 899-3970

DCB/dcm